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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,032	11/20/2003	Timothy A. Geiser	ACS 58145 (3166P)	2537
24201 7590 12/16/2008 FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045				
EXAMINER				
HOUSTON, ELIZABETH				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
12/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/720,032

**Applicant(s)**

GEISER ET AL.

**Examiner**

ELIZABETH HOUSTON

**Art Unit**

3731

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 18, 24-34, 37-39 and 44 is/are pending in the application.
- 4a) Of the above claim(s) 2, 5-7 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 8, 9, 18, 24-34, 38, 39 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Applicant is advised that should claims 2-4 be found allowable, claims 37-39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

2. Claim 1 is objected to because of the following informalities: Claim 1 recites the limitation "the distal portion" in lines 15-16. There is insufficient antecedent basis for this limitation in the claim since there is a previously recited "distal portion" of the inner member as well as a previously received "distal portion" of the outer member earlier in the claim. IT is understood by the examiner in light of the specification and by way of prior prosecution that "the distal portion" is referring back to a distal portion of the outer member. It is recommended that applicant clarify the matter to avoid unnecessary confusion. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3, 4, 8, 9, 18, 24-34, 38, 39, 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claims require the limitation "a *continuous direct* bond joining the layer of polyimide to the layer of nylon", which finds no support in the specification. The specification states that the sheath is made from a "Nylon-coated polyimide material" and that "a nylon material is bonded to the outside of a polyimide tubing". However there is no description of what type of bond is formed nor are there any figures that depict the layers and the bond.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 8, 9, 18, 25-32 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischell (USPN 5,792,144) in view of Wilson (USPN 6,019,778) and further in view of Vrba (USPN 6,254,609).**

7. Fischell discloses a catheter assembly (see entire document) comprising: a control handle (6); an inner catheter member including a distal mounting portion

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(defined by 71 and 23) adapted to have a medical device mounted thereon (40), a proximal portion (see 11 and 12, fig. 1) having a proximal end attached to the control handle, and a guide wire receiving member (63/65, Fig. 7) for receiving a guide wire (50), the guide wire receiving member being attached to the proximal portion of the inner catheter member (Col 7, lines 51-57 state that the metal joining tube (73) joins the guidewire lumen (65) to the shaft (72/12), the guide wire receiving member having a proximal end with an opening (66) and a distal end with an opening (19), a lumen (65) extending between these openings formed on the distal and proximal ends of the guide wire receiving member; and an outer catheter member (30) co-axially disposed over the inner catheter member and dimensioned for relative axial movement relative to each other, the outer catheter member having a distal portion (36) adapted to at least partially cover the medical device and a proximal end of the outer catheter attached to the control handle (Fig. 1), the outer catheter member being movable by the control handle to uncover the medical device, the outer catheter member including a proximal portion (32) having a lumen for receiving at least a portion of the inner catheter member and an intermediate portion (34) having a lumen through which the guide wire receiving member extends, wherein the proximal portion of the outer catheter member is attached to and extends into the lumen of the intermediate portion (see portion of Fig. 1 where arrow is 30 and note how 32 is connected to 34)) and the distal portion of the outer catheter member is attached to the intermediate portion. The proximal end of the guidewire receiving member, which does not extend through the lumen of the distal mounting portion, is slidably disposed within the lumen of the intermediate portion of the

outer catheter member. The distal mounting portion of the inner catheter member has a lumen (formed by (71) and (23)) and a portion of the guide wire member extends through the lumen (see Fig. 1 and 7). The guidewire member is secured to the wall (71) of the lumen at location (73). The lumen of the intermediate portion has a proximal opening (62) and the guidewire member extends into the opening.

8. Fischell does not disclose the sheath portion being made from a nylon-coated polyimide. However, Wilson discloses a sheath with an outer layer that is preferably nylon bonded to an inner layer that is preferably PTFE. (Col 6, line 33-39). IN the case of a braided reinforcement layer (70) disclosed by Wilson, there are multiple continuous direct bonds joining the polyimide to the nylon (continuous from one portion of braided wire to the adjacent portion of braided wire). Alternatively, Wilson contemplates the use of a coil in place of braid (C7:L14-16) where the bond between the coils would be a direct continuous bond from one end of the sheath to the other.

9. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate a sheath with a nylon outer layer and a PTFE inner layer since Wilson discloses that this is a preferable combination of materials for a sheath in a stent deliver device. The inventions are analogous with each other and the instant invention and therefore the combination is proper.

10. Fischell in view of Wilson does not disclose that the inner layer is a polyimide but rather a PTFE. Vrbica discloses that it is well known to substitute polyimide for PTFE as an inner layer of a sheath that is in direct contact with a stent. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate

polyimide into the inner layer of the sheath in place of PTFE. Fischell in view of Wilson discloses the claimed invention except for PTFE instead of polyimide. Vrba shows that polyimide is an equivalent material known in the art. Therefore, because the two materials were art recognized equivalents at the time of the invention was made, one of ordinary skill in the art would have found it obvious to substitute the polyimide for PTFE.

**11. Claims 3, 4, 24, 33, 34, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischell (USPN 5,792,144) in view of Wilson in view of Vrba and further in view of Cummings (USPN 6,736,839).**

12. Fischell modified by Wilson and Vrba discloses the invention substantially as claimed as stated above except for the proximal portion being formed from a hypotube. Cummings discloses a stent delivery device incorporating a sheath where in a hypotube is the proximal portion of the sheath or outer member (Col 3, line 60-67). The hypotube incorporates a flush lumen for flushing fluid. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate a hypotube into the proximal portion of the device disclosed by Fischell modified by Wilson and Vrba since it is well known in the art to use hypotubes for increased strength and pushability. It is well known in the art that hypotubes are made from stainless steel or nickel-titanium. With the incorporation of a hypotube, the proximal portion will inherently be less flexible than the intermediate portion.

***Response to Arguments***

13. Applicant's arguments filed 10/14/08 have been fully considered but they are not persuasive. Applicant asserts that Wilson does not disclose a "continuous direct bond" between the layers. However, as stated above, there are no reference points for where the bond begins and where the bond ends, so in the case of a braided reinforcing layer, Wilson discloses multiple continuous direct bonds. Further in the case of a coil, Wilson does in fact disclose a continuous direct bond.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH HOUSTON whose telephone number is (571)272-7134. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. H./  
Examiner, Art Unit 3731

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3731